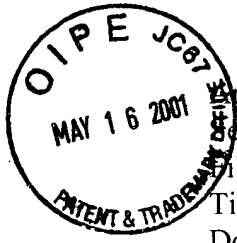


AF/1761 #15

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant : Allan Lepine
Serial No. : 09/163,778
Filed : September 30, 1998
Title : CANINE MILK SUBSTITUTE
Docket No. : IAM 0498 PA
Examiner : P. Dubois
Art Unit : 1761

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on May 14, 2001.

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Agent Susan M. Luna Reg. No. 38,769

BOX AF

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REPLY BRIEF ON APPEAL

This Reply Brief is being filed pursuant to the provisions of 37 CFR 1.193(b) in response to the Examiner's Answer mailed April 9, 2001. Arguments responsive to the issues raised in the Answer are set forth below. Pursuant to §1.193(b), the Examiner is requested either to acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief.

I. The Examiner has not established motivation to support a conclusion of obviousness with regard to the references of record.

In his Answer, the Examiner maintained all of the rejections against claims 1 and 3-14 as being obvious over the combined teachings of Oftedal, Kakade, Gil, Traitler, Kinumaki and Fujimori. While appellant previously pointed out that there is no teaching or suggestion in the references which provide motivation for the combination, the Examiner maintains at page 4 that all of the references provide a motivation to combine "either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." For example, the Examiner reasons that because Oftedal discloses a canine milk study and Kakade teaches a commercial milk replacer, "it would have been obvious to modify the milk taught by Oftedal to produce a commercial milk replacer." The Examiner appears to have taken the position that simply because commercial milk replacers exist for any mammal, the existence of such replacers

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supplies sufficient motivation to modify the natural milk of any other mammal. That is not the case. Neither reference is related to a milk replacer formulated to enhance the growth of nursing puppies as in the claimed invention. Oftedal relates to a study of bitch milk while Kakade is directed to a milk replacer having good shelf stability which is easy to mix and dilute on a farm. Nor do the references teach or suggest the claimed levels of protein or the claimed ratio of casein and whey.

While appellant previously pointed out that Oftedal does not teach the claimed protein ranges, the Examiner reasons at page 8 that such differences can be accounted for due to “different sampling and analytical procedures” and that one would have looked to Kakade for teaching a protein range of 13.3% to 32% and equated this with appellant’s teaching of about 35 to 45% protein. However, without the benefit of appellant’s application, one skilled in the art would not be motivated to choose one protein level over another, especially in view of the fact that neither of the references are directed to a milk substitute designed to enhance growth performance of nursing puppies. The Examiner further asserts that Kakade teaches that the protein may be provided at a variety of levels—again, this provides no motivation to provide the *claimed* protein level.

II. The Examiner has ignored the intended use and performance of the claimed composition compared with other commercially available milk replacers.

The Examiner has ignored the intended use of the milk substitute, arguing at page 5 that the claimed invention is directed to a “canine” milk substitute and thus could be used for “animals of any age”, not just for puppies. However, it is clear from the specification that the milk substitute was formulated for canines, specifically for nursing puppies. While the Examiner argues that the milk compositions taught in the prior art would be capable of performing the same intended use, the Examiner has overlooked the fact that none of the references teach or suggest the claimed amounts of each component in the claimed composition which, in combination, have been **proven** to provide enhanced growth performance when compared with other commercially available milk replacers. See the Examples.

III. One skilled in the art would not look to the cited references to produce a milk replacer formulated to enhance the growth performance of puppies.

While appellant previously pointed out that one would not look to human infant formulas or formulas designed for other animals such as farm animals in order to produce a canine milk substitute formulated for puppies, the Examiner reasons that one would look to the ingredients of other milk compositions "to enhance the benefits of a milk composition." The Examiner's reasoning again appears to be based on the false proposition that references from the same art provide sufficient motivation to combine their teachings. It is not understood how one skilled in the art would be motivated to add, subtract, or optimize certain ingredients from the prior art references without the benefit of appellant's specification.

IV. Conclusion

It is apparent from the Examiner's Answer in which bits and pieces of teachings from six different references are combined that the Examiner has not succeeded in carrying his burden of establishing a prima facie case of obviousness. Appellant submits that the proposed combination of references does not render obvious the appealed claims.

Respectfully submitted,

KILLWORTH, GOTTMAN, HAGAN
& SCHAEFF, L.L.P.

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